

REMARKS

Applicant has carefully reviewed the Office Action dated July 20, 2004 and thanks Examiner Dunwoody for the detailed review of the pending claims. Claims 2-14, 16, 17 and 32-40 are pending and stand rejected. Applicant respectfully requests reconsideration of the present application in view of the following remarks.

Claim Rejections – 35 USC §103

A. Claims 2-10, 12-14, 16, 17 and 32-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,186,557 to Funk in view of U.S. Patent No. 3,531,144 to Bizilia. For at least the following reasons, Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). See MPEP 2143.

In the present matter, Funk and Bizilia, either alone or in combination, fail to teach or suggest each of the claim limitations recited in the claimed invention. While Applicant agrees with the Examiner that Funk fails to disclose a locking member positioned between a retaining formation having at least one engagement feature and a second member, Applicant respectfully disagrees that “Bizilia teaches a locking member (14) being positioned between a retaining formation (7) and a second member (4) when the first (1) and second members are connected,” as proposed in the Office Action. Unlike the claimed invention, the proposed Bizilia retaining formation (7) is part of the second member (4) and, therefore, cannot be positioned therebetween. If anything, the locking member (14) in Bizilia is positioned between the first member (1) and the proposed retaining formation (7).

However, even if Funk and Bizilia taught or suggested each of the limitations of the claimed invention, which they do not, the cited references teach away from their combination. First, under *In re Japikse*, a reference renders the rearranging of parts obvious only if the rearrangement does not modify the operation of the device. Furthermore, according to MPEP 2144.04, “the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims [on appeal] is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex Parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). In the present matter, there is no motivation to combine Funk and Bizilia since the locking ring arrangement in Bizilia facilitates easy insertion (and correspondingly removal) of the male spindle (1) from the female socket (4). This feature is supported by the ability of the Bizilia locking ring (14) to move into and out of the locked position with groove (15) by mere movement of the male spindle (1) relative to the female socket (4). In contrast, the Funk coupling prevents easy removal of the male member (1) from the female member (2) unless the locking ring (3) is acted upon by the unlocking member (15). In fact, the Funk coupling prevents the locking ring (3) from moving into the unlocked position in groove (24) by mere movement of the male member (1) relative to the female member (2), as taught in Bizilia. Indeed, one would not want the male member (1) in Funk to be easily removed from the female member (2) by mere movement of the male member (1) relative to the female member (2), since the Funk coupling contains a pressurized fluid that urges this movement.

Second, Funk teaches a pipe connection that includes a first “male” member (1) having an annular support element (12) (split ring), which functions to retain the first member within the second member. Grooves (35), on the other hand, merely inhibit rotation of the first member (1) when received within second member (2), and do not function to retain first member (1) within the second member (2). The pipe connection in Funk also teaches a locking member (3) received within the second member (2). When the first member (1) is received within the second member (2), the locking member is held in tension between annular support element (12) and the abutment surface (25). Including engagement features in split ring (12) would not inhibit rotation of the first member (1) relative to the second member (2), since the annular support element (12) (split ring) is free to spin within groove (11) of first member (1).

Moreover, modifying the split ring (12) to include an engagement feature would likely render the split ring (12) incapable of supporting the load imposed by the first member (1).

Accordingly, modifying the Funk pipe connection as proposed in the Office Action would render the Funk pipe connection unfit for its intended purpose.

The claims that depend from claims 32 and 35 including additional patentably distinct limitations and, therefore, are patentably distinct as well. For example, Funk and Bizilia fail to teach or suggest a first member that includes an elbow, as recited in claim 40.

For at least the above reasons, the Examiner has failed to make out a prime facie case of obviousness with respect to claims 2-10, 12-14, 16, 17 and 32-40 and the rejection should be withdrawn.

B. Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over Funk in view of Bizilia and further in view of U.S Patent No. 4,280,723 to Moldestad. For at least the reasons described above with respect to claims 2-10, 12-14, 16, 17 and 32-40, the Examiner has failed to make out a prime facie case of obviousness with respect to claim 11 and the rejection should be withdrawn.

CONCLUSION

Applicant believes no fee is due beyond the fees identified in the accompanying transmittal. However, if an additional fee is due, please charge our Deposit Account No. 50-3145, under Order No. 209593-81528 from which the undersigned is authorized to draw.

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Respectfully submitted,

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